

REMARKS

Claims 53-75 are pending. Claims 53, 67, and 69 are the independent claims.

Each independent claim has been amended to recite "securing the lens to the frame, wherein the periphery of the cured material [that defines the lens] is not trimmed by more than a few millimeters prior to securing the lens to the frame." Support for this amendment can be found at, for example, at page 5, lines 21-31 of the specification. This additional language is intended to provide context for the meaning of the claimed expression a "first mold substantially in the shape of the frame chosen by the wearer," in that it is because the first mold has such a shape that the lens can be secured to the frame even though "the periphery of the cured material is not trimmed by more than a few millimeters prior to securing the lens to the frame."

The independent claims stand rejected as allegedly anticipated by U.S. Patent No. 3,940,304 ("Schuler"). The action concedes that the claimed limitation "substantially in the shape of a frame chosen by the wearer" is not explicitly disclosed in the Schuler, but argues that this limitation is inherent in Schuler. We traverse.

The MPEP makes it clear that: "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). MPEP § 2112(IV). The basis set forth in the present action plainly falls short of this exacting standard.

The Examiner has provided no evidence that Schuler *necessarily* discloses that his mold is "substantially in the shape of a frame chosen by the wearer." The only support provided in the action is: "Clearly, in disclosing non-circular molds and gaskets, the applied reference is disclosing molding non-circular lenses. It would only make sense to mold a non-circular lens in a mold, which is of the same general **shape** as that of the frame the lens would ultimately be fitted in. Note that the claims call for shape, not necessarily size." (Action at page 2).

Even assuming that the Action is correct as to what "makes sense," this is not the *necessary* disclosure required by the law. Moreover, there may be many reasons why the shape

of the mold in Schuler may differ from that of the frame – at least some of which “make sense.” For example, as explained in applicant’s specification, there are shrinkage problems associated with curing polymer-based lenses. So, for example, the shape of the mold may be guided by such shrinkage issues, or other process considerations, rather than the final shape of the lens to be fitted to the frame. Also, for example, the shape of the mold may be guided by mass-fabrication issues, whereas the ultimate shape of the lens may be guided by the end consumer, whose choices may vary. Absent evidence that Schuler could not possibly include these or other considerations, which may cause his mold to be in a shape substantially different from that of the frame chosen by the user, it cannot be said that the claimed limitation for the shape of the lens *necessarily* follows from Schuler. Accordingly, the anticipation rejection must be withdrawn.

Furthermore, the claims as presently amended further require “securing the lens to the frame, wherein the periphery of the cured material [that defines the lens] is not trimmed by more than a few millimeters prior to securing the lens to the frame.” So, even if Schuler *inherently* discloses that the mold is “substantially in the shape of a frame chosen by the wearer,” which we dispute as set forth above, it is certainly not that case that it *necessarily* follows from Schuler that the cured material “is not trimmed by more than a few millimeters prior to securing the lens to the frame,” as required by the claims. To the contrary, applicant’s specification explains that it is common in the prior art to trim cured lens by more than a few mm. Accordingly, the anticipation rejection must be withdrawn.

In addition to the anticipation rejection, the Action rejects all claims as unpatentable over Schuler. For example, the Action states: “If it is not inherent to mold the lens in the ultimate shape desired by the wearer –ie, the shape of the frame chosen by the wearer – than such certainly would have been obvious in order to reduce the amount of cutting and grinding to fashion the final lens. As pointed out supra, it simply would not make any sense to mold a lens with a desired non-circular shape and not mold such a lens in a mold which already has such a shape, wherein minimal grinding or cutting would be necessary” (Action at page 3.) We traverse.

In the context of the obviousness rejection, the Action concedes that Schuler does not disclose “supplying a non-circular first mold substantially in the shape of the frame chosen by the wearer,” as recited, for example, in claim 53. The Action does not point to any other prior art reference to find this missing limitation. Instead, the Action purports that “it simply would not make sense” to do anything other than what is claimed. (Action as page 3.) This is plainly insufficient to maintain a *prima facie* case of obviousness.

First, as indicated above in the context of the anticipation rejection, there might be many reason why one of ordinary skill in the art might supply the mold in a shape different from that of the frame chosen by the wearer. For example, there may be process considerations, such as shrinkage, or mass-fabrication issues.

More importantly, however, an obviousness rejection requires more than what might, or might not, make sense. Specifically, the MPEP requires that: “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143.03. Furthermore, it states: “It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” MPEP § 2144.03(E). Here, there is no evidentiary support to supply what is missing from Schuler.

To the contrary, if anything, Schuler teaches away from the claimed invention because he goes on to conclude that even when his lens requires no further grinding or polishing, it is a finished blank, or a so-called “uncut lens.”

“The plastic lenses of the present invention may be produced as a finished blank, or so-called ‘uncut lens’ or as an unfinished form, a so-called semi-finished lens, which may be subsequently ground and polished, if necessary, using the same technology and major equipment utilized on crown glass.” (Schuler at col. 7, lines 29-34.)

In other words, even when the resulting lens in Schuler is a *finished* blank, it is still an *uncut* lens, meaning that the edges of the lens have not yet been trimmed for mounting onto a frame.

The Action summarily dismisses this passage by stating – “Additional trimming would merely mean that the size of the lens would have to be adjusted, not its overall shape due to

frame constraints.” (Action at page 4.) Far from pointing to any section of the cited reference that *suggests* the missing claim element, the Action merely proposes an unsupported interpretation for a passage of the cited reference that otherwise clearly teaches away from the claimed invention. Even if the interpretation proposed by the Action is correct, the obviousness rejection must still fail because the Action has still failed to find all of the claimed limitation in the cited prior art, as required by MPEP §§ 2143.03 and 2144.03(E).

Moreover, the claims as currently amended, now require “securing the lens to the frame, wherein the periphery of the cured material [that defines the lens] is not trimmed by more than a few millimeters prior to securing the lens to the frame.” Because it is beyond dispute that Schuler teaches subsequent trimming of his finished lenses (even if, for the sake or argument only, this is done to adjust only size, and not shape), there can be no dispute that Schuler teaches away from the claims as currently amended, which are limited to cured lenses, that if trimmed at all, are only trimmed by a few mm, prior to securing them to the frame. Accordingly, the obviousness rejection must be withdrawn. MPEP § 2145(X)(D).

Finally, it appears that the only support for modifying Schuler to include all of the claim limitations come from Applicant’s own specification. For example, the Action states the proposed modification to Schuler is obvious “in order to reduce the amount of cutting and grinding to fashion the final lens.” (Action at page 3.) But this is taught, at least in part, by Applicant’s specification – and not in any prior art reference identified by the Examiner.

For example, applicant’s specification explains that supplying a non-circular first mold substantially in the shape of the frame chosen the wearer makes it possible to limit the amount of setting material used to form the lens and optimize the thickness of the final lens as a function of the frame and the user’s prescription. See, e.g., page 2, line 32, through page 3, line 33, and page 4, line 34, through page 5, line 3 of applicants’ specification. For example, it makes it possible to provide a lens which, for an equal power, is thinner than lenses adapted to the shape of the frame by prior art techniques that trim finished glasses - thereby reducing weight and increasing wearer comfort.

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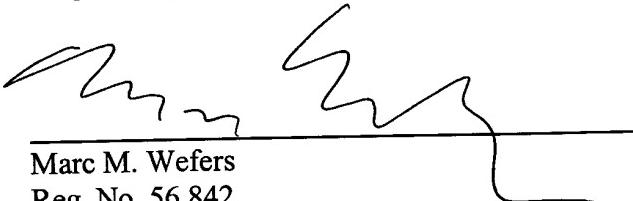
Accordingly, the obviousness rejection is a hindsight reconstruction, using the applicant's own invention as the basis for modifying the prior art. This is clearly impermissible under the law. For example, see *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

We submit the rejected dependent claims are allowable for at least the same reasons as those set forth above for the independent claims.

In view of the above, we ask that the prior art rejection be withdrawn and that the application be allowed. Enclosed is a \$1,020.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 08641-021001.

Respectfully submitted,

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